



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,837	01/07/2002	Brian Dalby	INVIT1280-1	5550

28213 7590 07/01/2002

GARY CARY WARE & FRIENDENRICH LLP
4365 EXECUTIVE DRIVE
SUITE 1600
SAN DIEGO, CA 92121-2189

EXAMINER

PAPPU, SITA S

ART UNIT	PAPER NUMBER
----------	--------------

1636

DATE MAILED: 07/01/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/937,837

Applicant(s)

DALBY ET AL.

Examiner

Sita Pappu

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-50 are pending in the instant application. IDS filed 01/07/2002 (paper #7) has been entered.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-18, 19-24, 25-28, 31-36, 38-50, drawn to a method for modulating a cellular process comprising contacting a cell with a cell process-modifying molecule, wherein the molecule is a polynucleotide attached to a translocating polypeptide and encodes a protein or enzyme.

Group II, claim(s) 1-18, 25-30, 31, 37-50 drawn to a method for modulating a cellular process comprising contacting a cell with a cell process-modifying molecule, wherein the molecule is a polynucleotide attached to a translocating polypeptide and encodes a single chain antibody.

Group III, claim(s) 1, 12-17, 19-28, 31-36, 38-41, 46, drawn to a method for modulating a cellular process comprising contacting a cell with a cell process-modifying molecule, wherein the molecule is a polypeptide attached to a translocating polypeptide.

Group IV, claim(s) 1, 12-17, 29, 31, 37, 38-41, 46, drawn to a method for modulating a cellular process comprising contacting a cell with a cell process-modifying molecule, wherein the molecule is a single chain antibody attached to a translocating polypeptide.

Claims 1, 12-17, 31, 38-41, 46 embrace the inventions of Groups I-IV. Should one of these Groups be elected, claims 1, 12-17, 31, 38-41, 46 will be examined only to the extent they encompass the elected subject matter.

Claims 2-11, 18, 42-45, 47-50 embrace the inventions of Groups I-II. Should one of these Groups be elected, claims 2-11, 18, 42-45, 47-50 will be examined only to the extent they encompass the elected subject matter.

Art Unit: 1636

Claims 19-24, 32-36 embrace the inventions of Groups I and III. Should one of these Groups be elected, claims 19-24, 32-36 will be examined only to the extent they encompass the elected subject matter.

Claims 25-28 embrace the inventions of Groups I, II and III. Should one of these Groups be elected, claims 25-28 will be examined only to the extent they encompass the elected subject matter.

Claims 29, 37 embrace the inventions of Groups II & IV. Should one of these Groups be elected, claims 29, 37 will be examined only to the extent they encompass the elected subject matter.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of groups I and II is a polynucleotide while the special technical feature of group III is a protein and that of group IV an antibody which are structurally different from one another, and exhibit different properties. The polynucleotides of Groups I and II encode different products (protein or enzyme, and an antibody respectively) that have different biological properties and functions.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1636

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sita S Pappu whose telephone number is (703) 305-5039. The examiner can normally be reached on Mon-Fri (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached on (703) 305 1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308 4242 for regular communications and (703) 872 9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst, Tracey Johnson, whose telephone number is (703) 305-2982.

S. Pappu
June 28, 2002

Anne-Marie Baker
ANNE-MARIE BAKER
PATENT EXAMINER